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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,088	01/30/2007	Oscar Moradei	03-552-C7	8922
20306 7590 01/22/2010 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER KUMAR, SHAILENDRA				
ART UNIT		PAPER NUMBER		
1621				
MAIL DATE		DELIVERY MODE		
01/22/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,088

Applicant(s)

MORADEI ET AL.

Examiner

SHAILENDRA KUMAR

Art Unit

1621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.

4a) Of the above claim(s) 3, 5-6, 7-20, 22-23, 27-

32, 55, 59, 82, 89, 112, 120, 143, 148, 172, 177, 201, 207, 231, 235, 259, 263, 287, 292, 316, 327, 329, 353, 355, 378, 380, 403, 405, 428, 4
30, 453, 455, 478, 480 and 503-511, is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1, 2, 4, 21 and 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-32,55,59,82,89,112,120,143,148,172,177,201,207,231,235,259,263,287,292,316,327,329,353,355,378,380,403,405,428,430,453,455,478,480 and 503-511.

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/27/09,7/29/08,11/9/07,7/26/07,10/10/06,3/23/06.

DETAILED ACTION

This office action is in response to applicants' communication filed on 11/10/09.

Claims 1-32, 55, 59, 82, 89, 112,120, 143, 148, 172, 177, 201, 207, 231,235, 259, 263, 287, 292, 316, 327, 329, 353, 355, 378, 380, 403, 405, 428, 430, 453, 455, 478, 480 and 503-511 are pending in this application.

Claims 33-54, 56-58, 60-81, 83-88, 90-111, 113-119, 121-142, 144-147, 149-171, 173-176, 178-200, 202-206, 208-230, 232-234, 236-258, 260-262, 264-286, 288-291, 293-315, 317-326, 328, 330-352, 354, 356-377, 379, 381-402, 404, 406-427,429, 431-452, 454, 456-477, 479, and 481-502 have been canceled.

Applicants' election of Group I, and compound 117aa, **without traverse** is acknowledged herewith.

Applicants point out that claims 1-2, 4, 6, 21,24-26 read on the elected species. **The examiner would like to point out that claim 6 does not read on the elected species. Claims 1-2, 4, 21 and 24-26 will be examined to the extent they read on the elected species and closely related compounds.**

Claims 3, 5-6, 7-20, 22-23, 27-32, 55, 59, 82, 89, 112,120, 143, 148, 172, 177, 201, 207, 231,235, 259, 263, 287, 292, 316, 327, 329, 353, 355, 378, 380, 403, 405, 428, 430, 453, 455, 478, 480 and 503-511 stand withdrawn from the consideration being drawn to the non elected invention.

At the outset, The examiner had pointed out to the Counsel that the original restriction requirement made included all the claims 1-503. However, the examiner found out that lots of claims have been canceled and, list of claims pending and canceled are

described above. Upon discussion with Mr. Michael Greenfield on 1/14/10, it was confirmed by the Counsel that no additional restriction requirement is necessary and applicants will still pursue Group I, i.e. now claims 1-32 without traverse. **However, slight modification of the restriction requirement is now as follows for the record:**

Group 1, claim(s) 1-32, drawn to histone deacetylase inhibitor compounds.

Group 2, claim(s) 55 and 59, drawn to compounds, when compounds are formula (3).

Group 3, claim(s) 82 and 89, drawn to compounds of formula(4),

Group 4, claim(s) 112 and 120, drawn to compounds of formula (5),

Group 5, claim(s) 143 and 148 drawn to compounds of formula (6)

Group 6, claim(s) 172 and 177 drawn to compounds of formula of claim 172,

Group 7, claim(s) 201 and 207 drawn to compounds of formula of claim 201

Group 8, claim(s) 231 and 235 drawn to compounds of formula of claim 231,

Group 9, claim(s) 259 and 263 drawn to compounds of formula of claim 259,

Group 10, claim(s) 287 and 292, drawn to compounds of formula of claim 287,

Group 11, claim(s) 316, 327 and 329, drawn to compounds of formula of claim 316,

Group 12, claim(s) 353 and 355. drawn to compounds of formula of claim 353,

Group 13, claim(s) 378 and 380. drawn to compounds of formula of claim 378,

Group 14, claim(s) 403 and 405. drawn to compounds of formula of claim 403,

Group 15, claim(s) 428 and 430. drawn to compounds of formula of claim 428,

Group 16, claim(s) 453 and 455. drawn to compounds of formula of claim 453,

Group 17, claim(s) 478 and 480. drawn to compounds of formula of claim 478,

Group 18, claims 503-511, drawn to composition and method of use.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 2/27/09, 7/29/08, 11/9/07, 7/26/07, 10/10/06 and 3/23/06 are in compliance with the provisions of 37

CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

Drawings

The drawings were received on 3/23/06. These drawings are acceptable.

Elected species appears to be free of prior art.

Claims 1-2, 4, 21 and 24-26 are objected to containing non elected subject matter, but would be allowable if rewritten in independent form including all of the limitations of the elected species and closely related subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on M-F, 7:30AM-5:00PM, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Kumar
1/15/10

/SHAILENDRA KUMAR/
Primary Examiner, Art Unit 1621